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Paper No. 10

WINNIE WANG
7F-3, NO. 79
SEC. 1, HSI-TAI-WU ROAD
HSI-CHIH, TAIPEI HSIEN, 221 TAIWAN

MAILED
DEC 06 2010
OFFICE OF PETITIONS

In re Patent No. 6,249,126 :
Issue Date: 06/19/2001 :
Application No. 09/339,036 : DECISION ON PETITION
Filed: 06/23/1999 :
Title: CAPACITY DETECTING CIRCUIT :
FOR A BATTERY :

This is in response to the PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b)), filed June 11, 2010.

The patent issued June 19, 2001. The second maintenance fee could have been paid during the period from June 19, 2008 through December 19, 2008 or with a surcharge during the period from December 20, 2008 through June 19, 2009. Accordingly, this patent expired on June 20, 2009, for failure to timely remit the second maintenance fee.

37 CFR 1.378(d) requires that any petition under 37 CFR 1.378 must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. There is no indication in the USPTO's records that Winnie Wang is an attorney or agent registered to practice before the USPTO or the patentee. Rather, it appears that Winnie Wang signed the present petition on behalf of the assignee. However, the Office does not consider Winnie Wang a person authorized to sign a petition under 37 CFR 1.378 because she failed to satisfy the requirements of 37 CFR 3.73(b)

Pursuant to 37 CFR 3.73:

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

- (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment)...For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or
 - (ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).
- (2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:
- (i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or
 - (ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

The Office notes that neither the present petition nor the patent file includes a Statement under 37 CFR 3.73(b) authorizing Winnie Wang to act on behalf of the assignee, Quitewin Technology Corporation. The Office will not presume from the filing of the present petition that it is signed by a proper party pursuant to 37 CFR 1.378(d). See generally, MPEP 324 and 37 CFR 3.73(b). Thus, the petition is improperly signed.

The Office will not treat the present petition on the merits until petitioner submits a "renewed" petition under 37 CFR 1.378(b), signed by a person(s) having authority to act (e.g. a registered patent

attorney or agent, the patentee, or the assignee accompanied by a Statement under 37 CFR 3.73(b)). Accordingly, the petition is dismissed.

Although the Office will not address the petition on its merits, the Office reminds petitioner that the Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee. 37 CFR 1.378(a).

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of a patent owner, and a patent owner is bound by the consequences of those actions or

inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987). Therefore, any delay caused by the negligence or mistakes of a patent owner's voluntarily chosen legal representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. at 317; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981).

The patent file does not indicate a change of address has been filed in this case, although the address given in the petition differs from the address of record. If petitioner desires to receive future correspondence regarding this patent, a change of correspondence address (and a power of attorney, if applicable) should be submitted. As a one-time courtesy, the Office will mail this decision to the address listed on the petition. Thereafter, all correspondence will be mailed to the address of record until the Office is notified otherwise.

In summary, petitioner must submit: (1) a "renewed" petition under 37 CFR 1.378(b) signed by an appropriate party as stated in 37 CFR 1.378(d); (2) a completed Statement Under 37 CFR 3.73(b) if the petition is being filed on behalf of the assignee; and, (3) a change of correspondence address signed by an appropriate party. Petitioner may supplement the petition if petitioner desires. The necessary forms accompany this communication for petitioner's convenience.

In the alternative, petitioner may wish to consider filing a petition under 37 CFR 1.378(c), requesting that the Office accept the unintentionally delayed payment of the second maintenance fee. The showing of unintentional delay is less burdensome and is evaluated under a less stringent standard than unavoidable delay.

A petition under 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period and be accompanied by (1) a verified statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the \$1,640.00 surcharge **(the \$700.00 surcharge previously paid may be credited thereto leaving a balance due of \$940.00)** set forth in 37 CFR 1.20(i)(2).

A copy of the form for a Petition to Accept the Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) accompanies this decision for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By fax: (571) 273-8300
ATTN: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Correspondence may also be submitted via EFS-Web.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Statement Under 37 CFR 3.73(b) Form (PTO/SB/96); Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) Form (PTO/SB/66); Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) Form (PTO/SB/65); and, Change of Address in a Patent Form (PTO/SB/123).